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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,983	06/09/1999	ANDERS R. WALLGREN	EFIM0346	7582

31408 7590 06/02/2006

LAW OFFICE OF JAMES TROSINO
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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/328,983	Applicant(s) WALLGREN ET AL.	
	Examiner Yogesh C. Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/30/2006 has been entered.

2. Applicant has canceled all previously presented claims 1-22 and presented new claims 23-38 which are now pending for examination.

Specification

3. The amendment filed 3/30/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: ***"selectively displaying to the user the modified instances of the object individually or collectively"***, in claims 23 and 31. The applicant has neither indicated support for this new limitation in his submission filed on 3/30/2006 nor examiner could find support on reviewing the applicant's specification. The examiner observes, see specification page 17, lines 12-22 and pages 23-27 that all the vendor instances are conveyed to the customer without any further filtering or limiting them for him to take further action.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in claims 23 and 31, ***“selectively displaying to the user the modified instances of the object individually or collectively”***, is not supported by the original disclosure. The applicant has neither indicated support for this new limitation in his submission filed on 3/30/2006 nor examiner could find support on reviewing the applicant's specification. The examiner observes, see specification page 17, lines 12-22 and pages 23-27 that all the vendor instances are conveyed to the customer without any further filtering or limiting them for him to take further action. Since balance claims, that is 24-30 and 32-38 are dependencies of claims 23 and 31 respectively, they inherit the same deficiency and are also rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

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are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thackston, in view of Hill, and further in view of Huberman.

With regards to claim 23, Thackston teaches a computer-based contracting method comprising:

receiving a user-supplied set of constraints regarding a job project; storing the set of constraints in a database as an object; creating a plurality of instances of the object, each instance uniquely associated with a corresponding vendor; communicating each instance of the object to its corresponding associated vendor; receiving communications from the user and the vendors to iteratively modify the instances of the object, the modifications further constraining the job project; selectively displaying to the user the modified instances of the object individually or collectively; and receiving a selection from the user of one of the vendors to complete the job project (see at least, col.3, line 64-col.6, line 35, col.8, lines 45-57, col.8, line45-col.13, line 25, col.15, line 28-col.16, line 4, col.17, line 34-col.25, line58, col.48, line 26-col.52, line17, FIG.2, FIG.3, " 394-EC Data", FIG.4, " 415-Contracts between prime contractors and suppliers Data module ", FIG.6, "394-EC Data", FIG.8,"890-Stored Time Multimedia Communications Sessions Data Module", FIG.9, " 988-Electronic Commerce Processing Module", FIG.10, " 1004-Contracts Module", FIG.12, FIG.13, " 1306 –Quasi-Real-Time Graphics Processing Module", FIG.14, " 988-Electronic Commerce Processing Module ", FIGs 26-28. Note: "templates" (col.13, lines 11-16, col.25, lines 25-58) correspond to request object and the changes made/negotiated/formalized during interactive communication processing with suppliers/vendors (col.24, line 28-col.25, line 25, col.8, lines 45-58) corresponds to vendor specific instances of a job request in the application. At least, col.50, lines 43-65, " The RFQ may include information

pertaining to how many rounds of bids will be considered...”, disclose series of iterative customer submissions and vendor responses. Col. 48, lines 26-43 disclose that the RFQ subject matter required by the user, that is prime contractor in Thackston, is stored in the form of a part design model and this object of part design model is communicated to qualified vendors [fabricators]. Further, see col.49, lines 3-13 discloses that based upon the bids received from the qualified vendors [fabricators] the user is able to select one or more vendors to complete the job and that also implies that the vendor’s responses are displayed on the GMR 2600 machine).

Applicant’s disclosure (page 5, lines 1-9) teaches that his invention is applicable for a custom manufacturing project and a print job can be an example. As per the disclosure, the invention is not directed to print job only. Though Thackston’s embodiment is related to an electronic commerce application for finalizing suppliers for an engineering project, he further teaches that other embodiments and uses of his invention are apparent to those having ordinary skill in the art as the same steps and system elements would be applicable for other applications. Thackston’s steps and system elements can be applicable to a print job also. In the same field of e-commerce, Huberman teaches a system and method to enable ordering and negotiating a print job on an electronic network (col.2, line 54-col.7, line 31). In view of Huberman, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Thackston to combine Huberman’s feature of ordering and negotiating a print job on an electronic network. Doing so would enable the system to create an electronic marketplace and bidding system where the buyers and suppliers could interactively negotiate/formalize specifications via templates of the job as explicitly disclosed in Thackston and provide open and efficient pricing practices for ordering print jobs on electronic networks as suggested in Huberman (col.2, 54-63). Thackston/Huberman does not disclose displaying

vendor specific instances in a combined view, that is collectively. However, Hill explicitly teaches comparing vendor specific instances in a combined view, that is collectively (see at least abstract, FIG.9, FIG.13, col.8, line 53-col.10, line 29). In view of Hill, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Thackston/Huberman to combine Hill's feature of comparing vendor specific instances in a combined view that is collectively. Doing so would enable the buyer to view two different images corresponding to two or more different vendors' quotes frames side by side and thus making comparison convenient and faster as explicitly discussed in Hill.

Regarding claims 24-26, it is already analyzed in claim 23 that Thackston/Huberman/Hill receives a request for a print job. Thackston further discloses that the set comprises a text description of the print job project/ a list of vendors to whom the instances of the object should be communicated/ a due date for the print job project (see at least col.50, lines 44-65 where, narrative description in the RFQ refers to "Text", delivery requirements in the RFQ refers to " a due date for print job project" and " listing of qualified fabricators" in the RFQ refers to. The list of vendors to whom the created RFQs, that is the vendor instances, be sent.).

Regarding claims 27-28 and 30, Thackston/Huberman/Hill discloses negotiations between the user and a plurality of vendors to enable the user to select a winning vendor as analyzed in claim 23. Thackston also discloses that the modifications comprise vendor-specified options for completing the print job project such as start times or dates or pricing options (see col.3, lines 22-49 which discloses that the negotiations with vendors include changes in the designs of items being ordered, their delivery requirements and costing and that implies that the vendor would negotiate all these changes including start times or dates and pricing options) .

Regarding claim 28, Thackston/Huberman/Hill discloses negotiations between the user and the a plurality of vendors to enable the user to select a winning vendor as analyzed in claim 23. Thackston also discloses that the vendor-specified options comprise media options (see Figs. 13 and 27-28 and col.49, line 46-col.50, line 65).

Regarding claims 31-38, their limitations are closely parallel to the limitations of claims 23-30 and are therefore analyzed and rejected on the basis of same rationale.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


(i) US Patent 5,758,328 to Giovannoli discloses receiving a user-supplied set of constraints regarding a requirement of a service/product in the form of buyer's filters, storing this requirement as the buyer's request for quotation [RFQ]in " The Quotation system", creating a plurality of instances of the RFQ in the form of E-mail or in FTP format and communicating them to the buyer specified vendors, receiving communications from the vendors which are displayed to the buyers for further processing and receiving a selection from the buyer ,see Fig.2A. Giovannoli also discloses, see col.7, lines 20-30, that before communicating the vendors' responses to the buyer, the computerized system selectively communicates/displays the vendors' responses based upon filter conditions, for example, selecting only those responses with the least shipping charges. Giovannoli's prior art renders claims 23 and 31 obvious.

(ii) US Patent 6,535,294 to Arledge, Jr. et al. discloses a computerized method and system for preparing customized print jobs over a communication network (see at least Abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
5/28/2006